

REMARKS/ARGUMENTS

The Office Action has been carefully considered. In the Office Action, claims were rejected in the following manner.

1. Claims 1-4, 6-7, 9-11, 26-29 and 31-32 were rejected under 35 U.S.C. § 102(e) as being anticipated by Day's US Patent No. 5,996,015 (hereinafter "*Day*").
2. Claims 5, 8 and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Day* in view of Rothman et al's US Publication No. 2001/0044851 (hereinafter "*Rothman*").

35 U.S.C. § 102(e) Rejections

Claims 1-4, 6-7, 9-11, 26-29 and 31-32 were rejected under 35 U.S.C. § 102(e) as being anticipated by *Day*. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131 (quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). Applicants respectfully submit that *Day* fails to teach all elements of the current claims.

Claim 1

Applicants respectfully submit that *Day* fails to teach all elements of Claim 1.

For example Claim 1 recites:

A computer implemented method of delivering digital media items to a user electronic device, the method comprising:

obtaining at the computer a playlist comprising a sequentially ordered plurality of digital media items that satisfies a set of restrictive criteria;

playing said playlist by the computer, wherein playing said playlist comprises sequentially delivering to the user electronic device, via a computer network, said sequentially ordered plurality of digital media items; and

while the computer is playing the playlist:

receiving, from the user electronic device, an indication to add a requested digital media item to the playlist;

evaluating whether adding the requested digital media item to the playlist would satisfy the set of restrictive criteria; and

when the set of restrictive criteria is satisfied, selectively adding the requested digital media item to the playlist for delivery to the user electronic device subsequent to receipt of the request.

Accordingly, Claim 1 is directed to a method of delivering media via a playlist, where the media from the playlist is played and additional media can be added to the playlist while the playlist is being played. Additionally, media that is present in the playlist or added to the playlist must satisfy a set of restrictive criteria. However, *Day* fails to teach or suggest all elements of Claim 1. Specifically, *Day* fails to teach or suggest **“receiving, from the user electronic device, an indication to add a requested digital media item to the playlist,”** wherein such receiving occurs **“while the computer is playing the playlist.”**

The Office Action asserts that these elements are taught in col. 3, lines 50-65 and col. 4, lines 1-12 of *Day*. These portions of *Day* read as follows:

The control server 211 functionality is to provide resource management and admission control for the entire server complex and includes the selection of data pumps and command processing. By controlling the number of multimedia or audio/video data streams, the control server 211 ensures that the quality of the service is maintained across the system. Specifically, the control server provides a plurality of multimedia file data stream control functions including the functions of "play", "stop", "pause", "rewind", "forward" and "seek". The control server also provides resource management, including admission control and load balancing, for both playing streams and content loading. In addition, the control server 211 stores a catalog of multimedia assets available on one or more data pumps 111. The application server 209 handles communication with the client requesting an asset. For example, an application server receives requests from a client and can issue VCR commands to control individual streams. The application server 209 can also include an optional content management database 217 containing additional information concerning the available assets, for example such information as the director, the subject and/or the actors for a particular video presentation.

Multimedia content management is handled through HTML forms on the server home page for example. **Users can add, delete, change and view "attributes" of assets. Asset attributes include information such as encoding type, frame rate and play rate.**

Applicants fail to see how the above passage teaches obtaining a request to add media to a playlist, let alone while media from the playlist is being played. The Office Action, on Page 4, cites that “user can add, delete, change and view attributes of the assets,” which is emphasized above, but a user’s ability to modify asset attributes is not analogous to a request to add media to a playlist, and there is no suggestion that such a request is obtained while media from the playlist is being played.

More specifically *Day* defines ‘attributes’ of an asset as being “information such as encoding type, frame rate and play rate” as emphasized above. Further, col. 4, lines 17-22 add

that “attributes for a file can be complemented by additional information describing the asset” and that such “information, which may be defined by the user, can include additional information items such as title, subject, actors, director, and date released.” Furthermore, “play rate” is defined in *Day* as relating to “the display scan rate and resolution of the display device.” See, for example, column 6, lines 9 – 25.

Even if users are able to modify information pertaining to media encoding type, frame rate, play rate, title, subject, actors, director, and date released, Applicants fail to see how this relates to or even suggests a playlist, and moreover, a request to add media to a playlist while the playlist is playing.

Applicants have reviewed *Day* in depth, and cannot find any portion that teaches or suggests **“receiving, from the user electronic device, an indication to add a requested digital media item to the playlist,”** wherein such receiving occurs **“while the computer is playing the playlist.”** Accordingly, Applicants respectfully assert that Claim 1 is patentable over *Day* and that Claim 1 is in condition for allowance.

Claims 2-4, 6-7 and 9-11

Claims 2-4, 6-7 and 9-11 depend from Claim 1, and are therefore patentable over *Day* at least by dependency. However, *Day* also fails to teach all elements of Claims 2-4, 6-7 and 9-11.

For example, *Day* also fails to teach or suggest that Claim 2, which includes the element: **“the set of restrictive criteria comprises whether the playlist satisfies a set of group preferences.”** Claim 2 therefore refers to preferences of a channel or playlist that define channel genre, type or category. This concept is discussed on page 13, lines 1-12, of the present specification, which reads:

The restrictive criteria applied to each request may depend on the channel in connection with which the request was made. Using distinct sets of restrictive criteria may beneficially help to maintain the logical character or category of each channel. For example, the media server 100 may broadcast a program of classical music on one channel and a program of rock music on another. **The categories of classical and rock music would define two distinct sets of group preferences. Accordingly, the restrictive criteria used in connection with each channel are preferably selected so that media played on each channel must conform to the set of group preferences associated with each channel.** If a client 102 were to request a rock music song on the classical music channel, the request would not satisfy the restrictive; therefore, the requested rock song would not be added to the classical music channel’s playlist 108. The restrictive criteria thus enable the system to maintain quality control.

In comparison, *Day* fails to disclose channels or playlists having group criteria that define a genre, type or category of the channel. Applicants have reviewed *Day* as a whole and the sections cited by the Office Action that allegedly teach group criteria, and Applicants fail to find disclosure or suggestion of the concept of “group criteria” as defined above.

Claim 3, is another example; *Day* fails to disclose “inserting a requested media item at a random position in the playlist,” as asserted by the Office Action. Although the Office Action cites col. 6, lines 37-64, as disclosing that “items are inserted on-the-fly prior to the end of the stream.” (Office Action, page 6), a careful reading of this section of *Day* reveals that in the context of *Day*, “on-the-fly” does not mean random, nor does it suggest insertion of a media item in a random position within a playlist.

Instead, *Day* col. 6, lines 37-64 discloses that the stream is generated or initiated segment- by-segment instead of the stream being fully rendered before playing (i.e. initiated “on-the-fly”). This is not the same as random insertion of content in a playlist. *Day* simply does not disclose such a concept. Accordingly, Applicants respectfully assert that Claim 3 is patentable over *Day* and further assert that Claim 3 is in condition for allowance.

Likewise, with Claim 6, *Day* also fails to disclose the elements of this claim. Specifically, *Day* fails to teach or suggest “restrictive criteria comprises whether fewer than a **substantial number** of media items are delivered” as recited by Claim 6.

The present specification, page 15, lines 2-5 define the term ‘substantial number’ as follows:

Accordingly, the processor 104 is programmed to schedule 210 fewer than a substantial number of media files at these times. In this context, a “substantial” number of media files correspond to the **number of recordings that will disallow a statutory license under the DMCA.**

As the Office Action states, in paragraphs 22 and 23 respectively, “*Day* fails to disclose the set of restrictive criteria comprises whether the playlist complies with the Digital Millennium Copyright Act requirement for obtaining a statutory license.” Moreover, *Day* fails to disclose that restrictive criteria can comprise whether fewer than the **number of recordings that will disallow a statutory license under the DMCA** of media items are delivered” Applicants therefore assert that Claim 6 is also patentable over *Day* and that Claim 6 is in condition for allowance.

Claims 26-29 and 31-32

Independent Claim 26 includes limitations analogous to Claim 1, therefore Claim 26 is allowable for the same reasons as Claim 1. Claims 27-29 and 31-32 depend from allowable Claim 26 and are allowable at least by dependency, and are also allowable for the reasons discussed above relating to Claims 2, 6, and 7 above.

35 U.S.C. § 103(a) Rejections

Claims 5, 8 and 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Day* in view of *Rothman*. To establish a *prima facie* case of obviousness, an Office Action must demonstrate that all claimed elements are taught or suggested by proffered prior art references. Section 2143.03 of the MPEP requires the “consideration” of every claim feature in an obviousness determination.

To render a claim unpatentable, however, the Office must do more than merely “consider” each and every feature for this claim. Instead, the asserted combination of cited references must also teach or suggest *each and every claim feature*. See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) (emphasis added) (to establish *prima facie* obviousness of a claimed invention, all the claim features must be taught or suggested by the prior art).

The failure of an asserted combination to teach or suggest each and every feature of a claim remains fatal to an obviousness rejection under 35 U.S.C. § 103, despite any recent revision to the Manual of Patent Examining Procedure (MPEP). In sum, it remains well-settled law that obviousness requires **at least a suggestion of all of the elements of a claim**. See *In re Wada and Murphy*, citing *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) and *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)).

Applicants respectfully assert that the Office Action fails to establish a *prima facie* case of obviousness because elements of Claims 5, 8 and 30 are not taught or suggested by *Day* or *Rothman*, either alone or in combination. For example, Claim 5 recites: “...wherein the set of restrictive criteria comprises whether the playlist complies with the Digital Millennium Copyright Act requirement **for obtaining a statutory license**.”

The Office action asserts that paragraph 0024 of *Rothman* teaches or suggests the elements of Claim 5. However, paragraph 0024 of *Rothman* reads as follows:

[0024] Furthermore the rights of web broadcasters such as "LIVE365" to deliver commercial content are governed in the United States by the Digital Millennium Copyright Act of 1999 (DMCA). The DMCA dictates the rules under which Internet broadcasters can broadcast commercial content over the Internet. **One of the requirements of the DMCA is that the listeners should not be able to predict the playlist in advance. If a station has a static playlist, on-demand broadcasting is perfectly predictable.** But simulated live broadcasting as implemented by current streaming servers scales with the number of broadcasters, not with the number of listeners, and therefore is infeasible for large systems in which there are many stations with no listeners.

While paragraph 0024 of *Rothman* does disclose the existence of the DMCA generally, it does not disclose that rules of the DMCA are actually used to modify how a playlist is presented or how media within a playlist is arranged or presented. More specifically, paragraph 0024 above fails to teach or suggest modification of a playlist or media presentation based on the DMCA **"requirement for obtaining a statutory license."**

For example, the present specification page 13, lines 17-23 and page 14, line 1 describes obtaining a statutory license under the DMCA as follows:

The Digital Millennium Copyright Act (DMCA) helps to solve this problem by allowing media service providers to obtain a statutory license on copyrighted works as long as the service is not an "interactive service." Under the DMCA, even if individuals can request specific sound recordings, a service is not "interactive" as long as "the programming on each channel of the service does not substantially consist of sound recordings that are performed within one hour of the requests or at the time designated by either the transmitting entity or the individual making such request."

Clearly, obtaining a statutory license under the DMCA requires substantially more than what is found in *Rothman*, paragraph 0024, and therefore *Rothman* fails to teach or suggest the elements of Claim 5. Accordingly, Claim 5 is patentable over *Day* and *Rothman*, either alone or in combination. Claims 8 and 30 comprise elements similar to those of Claim 5 and therefore Claims 8 and 30 are also patentable over *Day* and *Rothman*, either alone or in combination.

CONCLUSION

For at least the reasons above, Applicants respectfully submit that all pending claims are allowable and request that the Examiner permit these claims to proceed to issuance. Although additional arguments are believed to exist for distinguishing the cited documents, the arguments presented are believed sufficient to address the Examiner's rejections. Likewise, failure of the Applicants to respond to a position taken by the Examiner is not an indication of acceptance or acquiescence of the Examiner's position. Instead, it is believed that the Examiner's positions are rendered moot by the foregoing arguments, and it is therefore not believed necessary to respond to every position taken by the Examiner with which Applicants do not agree.

The Examiner is respectfully requested to contact the undersigned at the telephone number below if there are any remaining questions regarding this application.

We believe the appropriate fees accompany this transmission. If, however, insufficient fee payment or fee overpayment occurs, the amount may be withdrawn or deposited from/to AXIOS Law Group's deposit account. The deposit account number is 50-4051.

Respectfully submitted,
AXIOS LAW GROUP

Date: June 29, 2009

by: /Adam L.K. Philipp/

Adam L.K. Philipp - Reg. No.: 42,071

Direct: 206.217.2226

E-mail: adam@axioslaw.com

AXIOS Law Group
1525 4th Avenue, Suite 800
Seattle, WA 98101
Telephone: 206-217-2200
Customer No.: 61,857